

## Amendment/Response

Reply to Office Action of September 14, 2006

**REMARKS/DISCUSSION OF ISSUES**

Claims 1-9 are pending in this application, with claims 1, 4, and 7 being amended.

**Rejections under 35 U.S.C. § 102(a)**

Claims 4-6 are rejected as being anticipated by Prior Art Figure 1. Claim 4 is amended to positively recite the cassette as a claim limitation. Applicants note that the Patent Office is required to interpret means language under Section 112, sixth paragraph by referring to the specification. Applicants further note that Prior Art Figure 1 does not include any "secondary engagement means" as required by claim 4. Because claim 4 contains an element not disclosed in the prior art reference, it is suggested that the rejection for anticipation is overcome. Claims 5-6, being dependent upon and further defining independent claim 4, should be allowable for that reason, as well as for the additional recitations they contain. Therefore, reconsideration of the rejection of claims 4-6 under U.S.C. § 102(a) is respectfully requested.

**Rejections under 35 U.S.C. § 103(a)**

Claims 1-9 are rejected under U.S.C. § 103(a) as being unpatentable over Prior Art Figures 1, 2, and 6 (hereinafter admitted prior art, or APA) in view of Lyons. The rejection of the claims, as amended, is respectfully traversed.

One of the requirements for a *prima facie* case of obviousness is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. As Section 2143.01 states, the prior art must suggest the desirability of the claimed invention, and the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The Examiner states that the motive to combine features from the APA and Lyons is to vary the volume of the pod. Applicants are unable to fathom just how this motive applies to the claimed invention. As stated in the application, the purpose of the secondary engagement locations is to provide a location for the spring-loaded latchkeys to latch onto should the latchkeys fail to properly latch onto the primary engagement

**Amendment/Response****Reply to Office Action of September 14, 2006**

locations. Applicants are unable to find any motivation in the instant specification relating to varying the volume of the pod. Although Lyons has the motive of varying the volume of the pod in order to fit different sized objects within the pod, this motive has nothing to do with the claimed invention. Therefore, the rejection is invalid.

In addition, Lyons is from a non-analogous art and cannot be properly combined with the APA. The field of the claimed invention is reticle SMIF pods, as found in paragraph [01] of the specification. As Section 2141.01(a) of the MPEP states,

"The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."

The particular problem with which the inventor was concerned was the problem of latchkeys failing to engage the cassette properly (specification, paragraph [03]) and not the problem of designing a variable length packing container which overcame some of the limitations of the prior art (columns 1 and 2 of Lyons). Lyons is therefore non-analogous art and cannot be used in making a rejection under Section 103.

The Examiner states in his analysis of claim 7 that the pod is inherently capable of preventing the cassette from completely disengaging from the dome if the latchkeys fail to engage the primary latchkey receivers. Applicants are perplexed by this bald statement, since it is precisely the failure of this supposed capability that is the reason for the claimed invention. As stated in paragraph [03] of the specification, "If the latchkeys fail to engage the cassette properly, there is a risk that the cassette will separate from the dome, thus allowing the cassette and reticle to fall to the ground resulting in damage and/or contamination of the reticle." The purpose of the claimed invention is to prevent this stated risk. The Examiner is respectfully requested to provide some prior art showing that his statement relating to the "inherency" of the prior art is

**Amendment/Response**

**Reply to Office Action of September 14, 2006**

valid. Applicants do not believe that this "inherency" exists in the prior art; else they would not have devised the claimed invention.

In summary, it is respectfully suggested that there is no motive, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings as required by MPEP § 2143, and that Lyons is non-analogous art.

Claims 2-3, 5-6, and 8-9, being dependent upon and further defining independent claims 1, 4, and 7, respectively, should be allowable for that reason, as well as for the additional recitations they contain. Reconsideration of the rejection of claims 1-9 under U.S.C. § 103(a) is therefore respectfully requested.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated or by e-mail directed to [Chris@PatentingServices.com](mailto:Chris@PatentingServices.com).

Respectfully submitted,



Christopher R. Pastel, Reg. No. 37,694  
Attorney for Applicant(s)  
PASTEL LAW FIRM  
8 Perry Lane  
Ithaca, New York 14850  
Telephone: (607) 277-5907